THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LOUIS F. GENATOSSIO and THOMAS C. SCHROEDER

Appeal No. 97-2893
Application No. 29/038,948[1]

HEARD: December 9, 1997

Before HAIRSTON, STAAB, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to the appellants' request for rehearing[2] of our decision mailed December 24, 1997, wherein we

---

[1] Attorney Docket No. 02103/294001.

[2] Filed March 2, 1998.

affirmed the examiner's rejection of the appealed design claim under 35 U.S.C.
§ 112, second paragraph.

We have carefully considered the arguments raised by the appellants in their request for rehearing, however, those arguments do not persuade us that our decision was in error in any respect.

In the request, the appellants list five points believed to have been misapprehended or overlooked in rendering our decision. We will address each of these points in the order they are presented in the request.

First, the appellants argue that we overlooked or misapprehended that the claim under appeal points out the bounds between infringing and noninfringing conduct with greater particularity by including "substantially" in the claim because the settled rule is that a design patent is infringed if the accused design is substantially the same as the design shown in the drawings.

This is essentially a rehash of arguments previously made in the brief, and has been treated on pages 22-24 of our decision. It is not apparent to us how the presence of the word "substantially" in the Gorham[3] test for infringement[4] of a design claim mandates that it is proper, within the meaning of 35 U.S.C. § 112, second paragraph, for the appellants' design claim to include the word "substantially" in the absence of some standard or guideline in the specification apprising the designer of ordinary skill just what that term encompasses.

Second, the appellants contend that we overlooked or misapprehended the point that 37 CFR § 1.153(a), cited by us on pages 12-15 of our decision in support of our position, is in exactly the same form as when adopted on December 22, 1959, and in force when (1) the PTO issued the at least 18,537 design patents with "substantially" in the claim since 1971, and (2) two court decisions were decided. The first point the

[3] Gorham Mfg. Co. v. White, 81 U.S. (14 Wall) 511, 528 (1872).

[4] In an infringement action, both parties may present evidence on the issue of whether two designs are substantially the same.

appellants are apparently attempting to make is that the circumstance that numerous design patents issued with the word "substantially" in the claims since the inception of the rule establishes that the appellants' use of the word "substantially" is consistent with the settled practice of the PTO. The second point the appellants are apparently seeking to make is that the two court cases establish that the appellants' use of the word "substantially" does not render the claim indefinite under the second paragraph of 35 U.S.C. § 112.

As pointed out on pages 20-22 of our decision, we recognize that design patents have been issued with the word "substantially" appearing in the claim. However, the appellants have not cited any authority which holds that the issuance of a patent has any significant precedential value. In evaluating compliance with 35 U.S.C. §§ 112 and 171, each design application must be evaluated on the record developed in the Patent and Trademark Office (PTO). See In re Gyurik, 596 F.2d 1012, 1018 n.15, 201 USPQ 552, 558 n.15 (CCPA 1979) and In re Phillips, 315 F.2d 943, 945, 137 USPQ 369, 370 (CCPA 1963). To the extent any error has been made in the rejection or issuance

of claims in a particular application, the PTO and its examiners are not bound to repeat that error in subsequent applications. Accord, In re Donaldson Co., 16 F.3d 1189, 1194, 29 USPQ2d 1845, 1849 (Fed. Cir. 1994) ("The fact that the PTO may have failed to adhere to a statutory mandate over an extended period of time does not justify its continuing to do so."); In re Cooper, 254 F.2d 611, 617, 117 USPQ 396, 401 (CCPA), cert. denied, 358 U.S. 840, 119 USPQ 501 (1958) (decision in a trademark application in accordance with law is not governed by possibly erroneous past decisions of the Patent Office); In re Zahn, 617 F.2d 261, 267, 204 USPQ 988, 995 (CCPA 1980) ("[W]e are not saying the issuance of one patent is a precedent of much moment."); Ex parte Tayama, 24 USPQ2d 1614, 1618 (Bd. Pat. App. & Int. 1992) (prior issuance of patents for designs referred to as icons has no significant precedential value in evaluating compliance with 35 U.S.C. § 171). Compliance with §§ 112 and 171 requires analysis of the statutes and interpretation of case law. Mere reference to possibly contrary decisions of an examiner in other applications, applications in which the issue raised in this case was not even addressed, are not helpful in this analysis.

Furthermore, as we noted on page 22 of our decision, it is debatable whether or not this data establishes that for which it is cited.

As pointed out on pages 15-19 of our decision, the cases cited by the appellants are not controlling and do not support the appellants' position because none of them addresses the issue of how inclusion of the word "substantially" in a design claim impacts upon the requirement of 35 U.S.C. § 112, second paragraph, that an inventor must particularly point out and distinctly claim what he regards as his invention.[5]

Third, the appellants argue that we overlooked or misapprehended that the PTO is acting arbitrarily and capriciously to deprive the appellants of a property right without due process of law in granting design patents to other

[5] In fact, our research has not uncovered any final court or Board decision in which the issue of how inclusion of the word "substantially" in a design claim impacts upon the requirement of 35 U.S.C. § 112, second paragraph, was decided. This includes the cases cited by the examiner to support the rejection. Thus, there is no binding precedent for this panel of the Board to follow. See Ex parte Holt, 19 USPQ2d 1211, 1214 (Bd. Pat. App. & Int. 1991).

in "the ornamental design . . . substantially as shown and described" while denying such protection to the appellants.

We respectfully disagree with the appellants on this point. In our view, the PTO in the present case has advanced convincing reasoning in support of its position which has not been rebutted by the appellants. Under these circumstances, the PTO cannot be said to be acting arbitrarily and capriciously in refusing to grant the appellants a patent. Further, and as stated above, to the extent any error has been made in the rejection or issuance of claims in a particular application, the PTO and its examiners are not bound to repeat that error in subsequent applications.

Fourth, the appellants contend that we overlooked or misapprehended the impropriety of an MPEP ruling based on dictum in a footnote of a Board decision in conflict with authoritative rulings of binding precedent for more than a century.

This is apparently in regard to our reference on pages 19-20 of our decision to MPEP § 1504.04, and/or to the examiner's reliance on In re Sussman, 8 USPQ2d 1443 (Bd. Pat. App. & Int.

1988) in rejecting the claim. First, we did not rely on MPEP § 1504.04 in arriving at our decision. Second, we expressly stated on page 20 of our decision that we did not rely on Sussman in arriving at our conclusion that the standing rejection is sustainable. Third, it is not clear what "binding precedent" MPEP § 1504.04[6] or Sussman violate.

Finally, we simply disagree with appellants' final point that our decision, if correct, renders thousands of unexpired design and utility patents having the word "substantially" in the claim invalid. Our decision makes no such sweeping holding. Rather, our decision stands for the proposition that the definiteness of a design claim including language such as "substantially as shown and described" must be resolved in the same way definiteness issues are resolved in any other application involving words of degree, that is, on the basis of the particular facts of the involved application (i.e., on a case-by-case basis).

[6] MPEP § 1504.04 has been revised to delete the reference to Sussman.

In light of the foregoing, the appellants' request for rehearing is granted to the extent of reconsidering our decision, but is denied with respect to making any change thereto.

No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REQUEST FOR REHEARING - DENIED

KENNETH W. HAIRSTON Administrative Patent Judge	)
LAWRENCE J. STAAB Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)

Appeal No. 97-2893
Application No. 29/038,948

CHARLES HIEKEN
FISH & RICHARDSON
225 FRANKLIN ST.
BOSTON, MA 02110-2804

ON REQUEST FOR REHEARING

APPEAL NO. 97-2893 - JUDGE NASE
APPLICATION NO. 29/038,948

APJ NASE

APJ STAAB

APJ HAIRSTON

DECISION: **DENIED**

Prepared By: Gloria Henderson

DRAFT TYPED: 16 Oct 98

FINAL TYPED: